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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/507,315	09/10/2004	Bernd Zaschke	257253US0PCT	4070

22850 7590 03/27/2007

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EXAMINER	
COONEY, JOHN M	
ART UNIT	PAPER NUMBER
1711	

SHORTENED STATUTORY PERIOD OF RESPONSE	NOTIFICATION DATE	DELIVERY MODE
3 MONTHS	03/27/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Notice of this Office communication was sent electronically on the above-indicated "Notification Date" and has a shortened statutory period for reply of 3 MONTHS from 03/27/2007.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/507,315	ZASCHKE ET AL.	
	Examiner	Art Unit	
	John m. Cooney	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *28 December 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,2 and 4-17* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,2 and 4-17* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *10 September 2004* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *1206*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

Applicant's arguments filed 12-28-06 have been fully considered but they are not persuasive.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 2, and 4-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Applicants' claims are confusing as to intent because it can not be determined what degree of overlap in particle size distribution are intended to be included by the claim limitation "the peaks of the large and small particles...do not overlap". As determination of the beginning and end of a "peak" is a subjective determination, determination of what degree of overlap in particle size distribution is intended by the claims.

Applicants' arguments have been considered. However, rejection is maintained. Although one can readily ascertain what is meant by "do not overlap" in the context of the instant invention. The methods used to make the determinations defined by the claims must be definitively defined in the claims and/or described or readily ascertainable from the supporting, claim limitation defining portions of the supporting disclosure.

Additionally, the measurement standards set forth in the claims relate to foreign or non-readily recognizable test standards and, accordingly, determination of the metes

and bounds of applicants' claims can not be definitively determined. The specifications for performing the test standard methods need to be provided for the record. Appropriate correction is required.

Claim 16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims are confusing as to intent because it can not be determined what light scattering method methods are intended to be included or excluded from the determination methods defined by the claims used to determined the ranges of value limitations defined by the claims.

Applicants' arguments and amendment to claim 16 is noted. However, replacement of the term "the" with the term "a" do not serve to make identification of what methods of value determination are included or excluded from the metes and bounds of the claims more determinable, and applicants' arguments do not rebut the position set forth above.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 2, and 4-17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicants' limitation "wherein said large particles have a larger particle size than said small particles" recited in the claims is a limitation which lacks support in applicants' originally filed supporting disclosure. This is a new matter rejection.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1, 2, 4-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over EP-0,786,480 in view of Perry et al.(6,127,443).

EP-0,786,480 discloses preparations of polyurethane articles using polymer polyols which include polymer particles having narrow particle size distributions inclusive of the particle size distributions defined by applicants' claims (see abstract, as well as, the entire document).

EP-0,786,480 differs from applicants' claims in that combinations of different polymer polyols are not employed. However, Perry et al. discloses formations of

combinations of polymer polyols for the purpose of realization of unitary polyol mixtures for use in making energy management urethane articles (see column 5 and examples 1-5, as well as, the entire document). Accordingly, it would have been obvious for one having ordinary skill in the art to have employed blends of polymer polyols as disclosed by Perry et al. in the making of polyol materials and polyurethane articles of EP-0,786,480 for the purpose of achieving unitary polyol mixtures of combined polymer polyol ingredients for imparting the energy management effects of in order to arrive at the products and processes of applicants' claims with the expectation of success in the absence of a showing of new or unexpected results.

It has long been held that where the general conditions of the claims are disclosed in the prior art, discovering the optimal or workable ranges involves only routine skill in the art. *In re Aller,* 105 USPQ 233; *In re Reese* 129 USPQ 402 . Further, a prima facie case of obviousness has been held to exist where the proportions of a reference are close enough to those of the claims to lead to an expectation of similar properties. *Titanium Metals v Banner* 227 USPQ 773. **(see also MPEP 2144.05 I)** Similarly, it has been held that discovering the optimum value of a result effective variable involves only routine skill in the art. *In re Boesch,* 617 F.2d 272,205 USPQ 215 (CCPA 1980). The size of particles employed in the formation of polymer polyols are well studied, and polymer particle size differences have well known and expected effects on the stabilities and viscosities of the polyols which containing said polymer particles and on the physical properties of articles realized from the polymer polyols formed. Combinations of results arriving from the employment of blends of these

polymer polyols having different particle sizes is not seen to rise above optimization of that which is known from the teachings of the prior art, and a demonstrated showings of new or unexpected results commensurate in scope with the scope of the claims is not seen to have been set forth in the evidence of record.

Applicants' arguments have been considered. However, rejection is maintained for the reasons set forth above. It is the secondary teaching that is looked to for the teaching and the motivation to employ blends of polymer polyols. It is not seen that looking to the secondary teaching for its teaching of the use of blends of polymer polyols in the manner indicated in the rejection above would destroy the essential teachings of the primary reference as alleged by applicants. Though the primary reference is directed towards employment of polyols having narrow particle size distribution, it is not seen that employing multiple polymer polyols as provided for by the secondary teaching to arrive at preparations involving blends of polymer polyols having more than one narrow particle size distribution would destroy the essential teachings of the primary reference.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Cooney whose telephone number is 571-272-1070. The examiner can normally be reached on M-F from 9 to 6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck, can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JOHN M. COONEY JR.
PRIMARY EXAMINER
Group 1700